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page 11, in particular, page 11, lines 4-22. Line 20 discusses that the matrix materials are thermoplastic materials.

Claims 16, 18, 19, 22-24, 26-31, 34 and 35 were rejected under 35 U.S.C. § 102(b) as being anticipated by Jankower *et al.* EP 0 351 943 ("Jankower"). Claims 16-22, 27, 28, 31 and 33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lo *et al.* U.S. Patent No. 6,358,520 ("Lo") in view of Hasslin U.S. Patent No. 5,674,514 ("Hasslin"). Claims 16-33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Jankower in view of Minami *et al.* EP 0 466 279 ("Minami"). The applicants respectfully traverse these rejections.

#### Section 102 Rejection

Claims 16, 18, 19, 22-24, 26-31, 34 and 35 were rejected under 35 U.S.C. § 102(b) as being anticipated by Jankower. The applicants' claimed invention requires a thermoplastic cycloolefin copolymer. Jankower does not disclose nor teach that the microparticle comprises a thermoplastic cycloolefin copolymer as is claimed by the applicants' claimed invention. For the above reasons, this rejection should be withdrawn.

#### 103 Rejections

Claims 16-22, 27, 28, 31 and 33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lo in view of Hasslin. Claims 16-33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Jankower in view of Minami. The applicants believe that Lo is the closest prior art.

Lo discloses a matrix comprising a water-insoluble pesticide microencapsulated in a shell and further comprising water-soluble polymers such as acrylic acid polymers. However, the present invention relates to a microparticle wherein the active substance is

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not microencapsulated in a shell but is embedded into the polymer matrix (see the specification at page 2, 1st paragraph and claim 18). Moreover the microparticle of the present invention comprises a water insoluble polymer, namely a thermoplastic cycloolefin-copolymer. Such microparticle provides all the advantages as set forth at pages 2 and 3 of the specification. As the Examiner has correctly recognized, Lo does not disclose the use of a thermoplastic cycloolefin copolymer as is required by the applicants' claimed invention. Lo describes the polymers at col. 3, lines 45-54.

In a microcapsule the shell-material forms a hollow wherein the active substance is contained. However, a microparticle is a solid body wherein the active substance is embedded in the material. Moreover, Hasslin, which is the secondary reference to Lo, does not even disclose thermoplastic cycloolefin copolymers and the particular advantages related to their use as microparticles.

Hasslin does not give a hint to modify the embodiment of Lo in the sense of the present invention in order to render the advantageous microparticle of the present invention. Hasslin discloses many different types of polymers including cycloolefin polymers (col. 3, line 35), but this disclosure is in a laundry list of polymers that extends from col. 3, line 30 through col. 5, line 64. This list includes a group of twenty-two broad groups. It is noted that none of the specific examples of commercially available polymers disclosed at col. 5, lines 51-64 include a cycloolefin copolymer. There would be no reason for a person of ordinary skill in the art to select a cycloolefin copolymer from the multitude of polymers listed. Hasslin does not even disclose the particular advantages of the cycloolefin copolymers.

**Rejection Over Jankower In View Of Minami**

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The present invention relates to a microparticle providing all the advantages set forth at pages 2 and 3 of the instant specification. There is no hint in Minami to modify the embodiment of Jankower in the sense of the present invention in order to render the advantageous microparticle of the present invention. The Examiner's reasoning is clearly based on a hindsight reconstruction of the present invention.

The Examiner must consider the references as a whole, In re Yates, 211 USPQ 1149 (CCPA 1981). The Examiner cannot selectively pick and choose from the disclosed multitude of parameters without any direction as to the particular one selection of the reference without proper motivation. The mere fact that the prior art may be modified to reflect features of the claimed invention does not make modification, and hence claimed invention, obvious unless desirability of such modification is suggested by the prior art (In re Baird, 29 USPQ 2d 1550 (CAFC 1994) and In re Fritch, 23 USPQ 2nd. 1780 (Fed. Cir. 1992)). The applicants disagree with the Examiner why one skilled in the art with the knowledge of the references would selectively modify the references in order to arrive at the applicants' claimed invention. The Examiner's argument is clearly based on hindsight reconstruction.

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching, suggestion, or incentive supporting this combination, although it may have been obvious to try various combinations of teachings of the prior art references to achieve the applicant's claimed invention, such evidence does not establish prima facie case of obviousness (In re Geiger, 2 USPQ 2d. 1276 (Fed. Cir. 1987)). There would be no reason for one skilled in the art to combine Lo in view of Hasslin and

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Jankower in view of Minami.

For the above reasons, these rejections should be withdrawn.

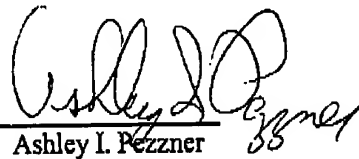
No additional fees are due. If there are any additional fees due in connection with the filing of this response, including any fees required for an additional extension of time under 37 CFR 1.136, such an extension is requested and the Commissioner is authorized to charge or credit any overpayment to Deposit Account No. 03-2775.

For the reasons set forth above, Applicants believe that the claims are patentable over the references cited and applied by the Examiner and a prompt and favorable action is solicited. The applicants believe that these claims are in condition for allowance, however, if the Examiner disagrees, the applicants respectfully request that the Examiner telephone the undersigned at (302) 888-6270.

Respectfully submitted,

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APPENDIX  
MARKED-UP VERSION OF CLAIM 16

16. A microparticle for controlled active-substance release comprising at least one active substance and at least one thermoplastic cycloolefin copolymer.

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